



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,068	08/22/2003	Louis C. Argenta	0101 P02977US1	9699

110                      7590                      08/11/2006

DANN, DORFMAN, HERRELL & SKILLMAN  
1601 MARKET STREET  
SUITE 2400  
PHILADELPHIA, PA 19103-2307

EXAMINER

PHILOGENE, PEDRO

ART UNIT                      PAPER NUMBER

3733

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



Art Unit: 3733

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 10/227,161. Although the conflicting claims are not identical, they are not patentably distinct from each other because it is clear that all the elements of claims 1-13 of the '161 application, are to be found in claims 1-13 of '161 application. The difference between these two sets of claims lies in the fact that the claims of the '068 application includes many more elements and is thus much more specific. Thus the invention of claims 1-13 of the '161 application is in effect a "species of the "generic" invention of claims 1-13 of the '068 application. It has been held that the generic invention is "anticipated" by the "species". See *in re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993). Since, claims 1-13 of the '068 application are anticipated by claims 1-13 of the '161 application, they are not patentably distinct from claims 1-13 of the '161 application.

Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-45,96-103, 113-121 of copending Application No. 10/161,076 in view of Dunn et al. (5,717,030). Dunn et al teach a system that can be implanted anywhere in the body including bone, as best seen in column 5, lines 19-22. The system can be biodegradable and the active ingredient can include bone growth agents. Therefore, Dunn teach a bone substitute material that is bioabsorbable to promote bone growth. It would have been obvious to one having ordinary skill in the art to modify the copending claims to include bone substitute material at the wound to repair bone tissue. The copending claims already recite the treatment of repairing bone tissue. Dunn et al teach the details of the material that would provide the recited function.

Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-14,16-19,23-30,32,33,37-50,52-56,84-132 of copending Application No. 09/863,234 in view of Dunn et al. (5,717,030). Dunn et al teach a system that can be implanted anywhere in the body including bone, as best seen in column 5, lines 19-22. The system can be biodegradable and the active ingredient can include bone growth agents. Therefore, Dunn teach a bone substitute material that is bioabsorbable to promote bone growth. It would have been obvious to one having ordinary skill in the art to modify the copending claims to include bone substitute material at the wound to repair bone tissue. The copending claims already recite the treatment of repairing bone tissue. Dunn et al teach the details of the material that would provide the recited function.

Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-14,16-19,23-30,32,33,37-50,52-56,84-132 of copending Application No. 09/863,234 in view of Dunn et al. (5,717,030). Dunn et al teach a system that can be implanted anywhere in the body including bone, as best seen in column 5, lines 19-22. The system can be biodegradable and the active ingredient can include bone growth agents. Therefore, Dunn teach a bone substitute material that is bioabsorbable to promote bone growth. It would have been obvious to one having ordinary skill in the art to modify the copending claims to include bone substitute material at the wound to repair bone tissue. The copending claims already recite the treatment of repairing bone tissue. Dunn et al teach the details of the material that would provide the recited function.

Claims 1-13 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 38-41,43-46,71-80,83-86 of copending Application No. 09/026,353 in view of Dunn et al. (5,717,030). Dunn et al teach a system that can be implanted anywhere in the body including bone, as best seen in column 5, lines 19-22. The system can be biodegradable and the active ingredient can include bone growth agents. Therefore, Dunn teach a bone substitute material that is bioabsorbable to promote bone growth. It would have been obvious to one having ordinary skill in the art to modify the copending claims to include bone substitute material at the wound to repair bone tissue. The copending claims already recite the treatment of repairing bone tissue. Dunn et al teach the details of the material that would provide the recited function.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Response to Arguments***

Applicant's arguments, see Remarks, filed 5/9/06, with respect to claims 1-13 have been fully considered and are persuasive. The 103 rejection of claims 1-13 has been withdrawn. However, the double patenting rejection of the claims is still maintained.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene  
August 01, 2006



PEDRO PHILOGENE  
PRIMARY EXAMINER